



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,301	02/06/2004	Jeremy Irish	015.0405.US.CON	5416
22895	7590	08/10/2006	EXAMINER	
PATRICK J S INOUE P S			MANCHO, RONNIE M	
810 3RD AVENUE			ART UNIT	
SUITE 258			PAPER NUMBER	
SEATTLE, WA 98104			3663	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,301

Applicant(s)

IRISH ET AL.

Examiner

Ronnie Mancho

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-5 and species "a" in the reply filed on 5/15/06 is acknowledged. It is further noted that applicant in the response submitted 12-4-05 elected claims 1-5 without traverse. However, in the response submitted 5/15/06, the applicant has now elected claims 1-5 and species "a" with traverse and rescinded the election without traverse of claims 1-5.

The applicant traverses the rejection because the examiner did not give the reason why the claims should be restricted into species. In response, applicant's admission of different embodiments in the disclosure suffices as reason to restrict the claims into species. The applicant further argues that the examiner should show that there will be serious burden if the claims are not restricted. In response, the requirement for serious burden is disclosed in MPEP 808.02 wherein the classification of the claims into different class of search is a showing of serious burden.

It is further noted that the embodiments disclosed by the applicant are distinct and mutually exclusive.

2. Claims 6-26 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/14/05.

Therefore, the election restriction requirement is deemed proper and stands.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In claim 1, the applicant recites, “executing a user-definable event”. The limitation is interpreted to mean that the even has not been defined yet. The event is only recited as being definable. Therefore one skilled in the art would not be able to execute an event that has not been defined.

The applicant further recites, “zones of influence”. One skilled in the art cannot ascertain what is being influenced with regard to the claimed “zones”, or does a zone of influence refer to zone that has a mountain that influences flow of traffic or a river that influences the economy of a region, etc? Since the claimed “zone of influence” cannot be ascertained, the scope of the rest of the limitations in the claims cannot be ascertained. The applicant further claims “a logically enclosed physical space”. The limitation is indefinite because it is not clear what all is meant and encompassed by “a logically enclosed physical space”. It noted in the restriction requirement that the applicant elected species “a” which refers to applicant’s fig. 1. As seen from fig. 1, there is disclosed no “logically enclosed physical space”.

It is further not clear what all is meant by and encompassed by the limitations “a user device executing a cartridge comprising identifying a location of the user device 10 based on further geolocational data and locally triggering at least one user-definable event (i.e. a new clue)

Art Unit: 3663

when the location substantially correlates to the stored geolocational data for the trigger condition of the at least one user-definable event”.

The rest of the claims are rejected for depending on independent claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Sporgis (6320495).

Regarding claim 1, Sporgis (figs. 1-4)discloses a system for executing user-definable events (col. 3, lines 19-27) triggered through geolocational data (fig. 3) describing zones of influence, comprising:

a cartridge (col. 4, lines 14-24; i.e. a collection of zones, items, events, etc; see specification, page 7, line 3) defining one or more zones of influence, each zone of influence described by stored geolocational data and forming a logically enclosed physical space (col. 4, lines 14-24; figs. 3&4), the cartridge further associating one or more user-definable events (i.e. individualized; col. 3, lines 63-65, lines 19-26) with each zone of influence (col. 4, lines 14-15), each user-definable event specifying a trigger condition (col. 5, lines 4-9) based on the stored geolocational data (col. 5, lines 9-14) for the associated zone of influence; and

Art Unit: 3663

a user device 10 (col. 3, lines 1-18) executing a cartridge (col. 4, lines 14-24; i.e. a collection of zones, items, events, etc; see specification, page 7, line 3) comprising identifying a location of the user device 10 based on further geolocational data (col. 5, lines 9-14) and locally triggering at least one user-definable event (i.e. a new clue) when the location substantially correlates to the stored geolocational data for the trigger condition of the at least one user-definable event (col. 5, lines 9-23).

Regarding claim 2, Sporgis (figs. 1-4) discloses the system according to claim 1, wherein the cartridge 11 defines one or more timed events specified by a start time and a duration and associates one or more of the user-definable events with each timed event, further comprising:

a timer to measure an elapsed time from the start time of each timed event, wherein the trigger triggers at least one user-definable event when the elapsed time substantially equals the duration of one such timed event.

Regarding claim 3, Sporgis (figs. 1-4) discloses the system of claim 1, wherein the cartridge defines one or more independent trigger conditions and associates one or more of the user-definable events with each independent trigger condition, and the trigger triggers at least one user-definable event upon satisfaction of at least one independent trigger condition, and the trigger at least one user-definable event upon satisfaction of at least one independent trigger condition

Regarding claim 4, Sporgis (figs. 1-4) discloses the system according to Claim 1, wherein the cartridge defines each zone of influence as discrete, adjoining, overlapping, and nested relative to at least one other zone of influence.

Regarding claim 5, Sporgis (figs. 1-4) discloses the system according to Claim 1, wherein the cartridge defines at least one zone of influence as inheriting at least one user-definable event from one or more other of the other zones of influence.

MPEP 2114

8. The statements of intended use or field of use, "for executing", "user-definable event", "triggered through", "forming a", "associating one or more user-definable events", "specifying afor ", "identifying a.....based on", "locally triggering.....when", "correlates to.....for", "the cartridge defines", "associates", "triggerswhen.....equals", "triggers.....upon satisfaction of.....trigger condition", etc clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647 Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

Art Unit: 3663

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Response to Arguments

Art Unit: 3663

9. Applicant's arguments filed 12/14/05 and 5/15/06 have been fully considered but they are not persuasive.

In the arguments submitted 12-14-05, the applicant argues that the prior art does not teach “executing the cartridge”. The examiner disagrees. The limitation is a method limitation in an apparatus claim. The prior art is capable of “executing the cartridge” since the prior art anticipates the structural limitations of the claims. It is believed that prior anticipates executing a cartridge (col. 4, lines 14-24; i.e. a collection of zones, items, events, etc; see specification, page 7, line 3) comprising identifying a location of the user device 10 based on further geolocational data (col. 5, lines 9-14). It is further noted that the limitation has a 112 rejection above.

Applicant further argues that the prior art does not anticipate “associating one or more user-definable events”, etc. The examiner disagrees. These limitations are just verbose and are all directed to MPEP 114 as pointed above. It is believed that the prior art anticipates “associating one or more user-definable events (i.e. individualized; col. 3, lines 63-65, lines 19-26) with each zone of influence (col. 4, lines 14-15), each user-definable event specifying a trigger condition (col. 5, lines 4-9) based on the stored geolocational data (col. 5, lines 9-14) for the associated zone of influence”.

The applicant further argues that the prior art does not anticipate “executing a user-definable event”. This limitation again is indefinite as pointed out above. It is not clear what limitations are included or not included in the claims. The applicant further argues that claim 1 provides non-linear events. In response, “non-linear events” was not in the claims.

The rejections are proper and stand.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3663

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronnie Mancho
Examiner
Art Unit 3663

August 3, 2006


JACK KEITH
SUPERVISORY PATENT EXAMINER